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APPLICATION NO.
09/470,580

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
ON APPEAL FROM THE EXAMINER TO THE BOARD
OF PATENT APPEALS AND INTERFERENCES**

In re Application of:	SOLOMON, et al.
Serial No.:	09/470,580
Filing Date:	December 22, 1999
Group Art Unit:	3622
Examiner:	James W. Myhre
Title:	REBATE PROCESSING SYSTEM AND METHOD OFFERING SELECTABLE DISBURSEMENT OPTIONS

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

APPEAL BRIEF

Appellants have appealed to this Board from the decision of the Examiner, contained in a Final Office Action mailed July 12, 2004 ("*Final Office Action*"), finally rejecting Claims 1, 3, 4, 6-11, 13, 14, 16-31, and 33-38. Appellants mailed a Notice of Appeal on October 12, 2004. Appellants submit this Appeal Brief.

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Real Party In Interest

The real party in interest for this Application under appeal is Parago, Inc. of Dallas, Texas.

Related Appeals And Interferences

The Appellants, the undersigned Attorney for Appellants, and the Assignee know of the following application on appeal that may directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal: United States Patent Application Serial No. 09/470,582, filed on December 22, 1999, appeal filed on July 12, 2004.

Status Of Claims

Claims 2, 5, 12, 15, and 32 were canceled previously. Claims 1, 3, 4, 6-11, 13, 14, 16-31, and 33-38 were rejected in the *Final Office Action* mailed July 12, 2004. Claims 1, 3, 4, 6-11, 13, 14, 16-31, and 33-38 are all presented for appeal and are set forth in Appendix A.

Status of Amendments

According to the Advisory Action mailed October 22, 2004 (*"Advisory Action"*), the Examiner will enter the amendments to the claims presented in the Response After Final filed September 23, 2004 (*"Response After Final"*).

Summary of Claimed Subject Matter

Traditional rebates offer cash back to customers who fulfill a set of requirements after purchasing a product. *Specification*, at page 2, lines 2-19. For example, after purchasing a computer bearing a rebate, the purchaser may submit physical documentation to receive cash back from the computer manufacturer. These post-purchase requirements give rebate programs an advantage over other types of product discounts, such as coupons. For example, since coupon discounts apply at product purchase, the customer pays a reduced price at the purchase. With a rebate, the customer pays full price and then must perform tasks to receive the rebate. If the customer fails to appropriately perform the tasks, the rebate is never paid. Therefore, a rebate can generate a sale without ever being redeemed, whereas a coupon that generates a sale is inherently used to discount the purchase price.

The present invention encompasses a number of embodiments for automating, consolidating, and streamlining rebate processes, while maintaining key aspects of rebate programs that provide enhanced value. *Id.*, at page 3, lines 2-11. A rebate processing center provides a unified system for managing information relating to rebate promotions, processing rebate requests, and interfacing with rebate sponsors and consumers. *Id.*, at page 8, line 21 - page 9, line 8.

The information managed by the rebate processing center can include rebate promotion data and transaction information relating to product purchases. *Id.*, at page 10, lines 9-23. The rebate promotion data details information relating to rebate offers, such as sponsor information, product information, rebate requirements, disbursement options, and statistical information. *Id.*, at Fig. 3 and page 10, line 31 - page 13, line 14. For example, data for a particular rebate promotion may indicate the promotion sponsor, a product identifier, documentation required to receive the rebate, valid purchase dates for the promotion, various options for receiving the rebate, and statistics for the promotion. *Id.* The transaction information details purchases of products by consumers and tracks consumer activities to fulfill rebate requirements. *Id.*, at Fig. 4. and page 13, line 15 - page 16, line 18. For example, the transaction information may include an entry identifying a consumer, a product, a promotion, and purchase information. *Id.* To process rebates, the rebate processing center associates the promotion and transaction information to identify consumers who have satisfied rebate requirements.

The rebate processing center may also enable interaction with promotion sponsors and with consumers. *Id.*, at Figs. 5-10. For example, using contact information, such as an email address provided by a consumer, the rebate processing center can provide status updates at appropriate times. This and other user interfacing aspects can enhance the consumer's satisfaction with the rebate process, even though the system as a whole maintains the potential for breakage.

According to particular embodiments, the rebate processing center enables consumers to select between various disbursement options for receiving an authorized rebate. *Id.*, at page 12, lines 12-23 and Fig. 9. For example, the disbursement options for a rebate may include $5.00 cash back or a $15.00 purchase credit. By providing options with different cash values to the recipient, the rebate processing center can incent consumers to choose options other than cash. This can, in turn, drive increased sales while maintaining consumer satisfaction.

Various figures provide illustrative examples of these concepts. In particular, Figure 4 shows an example of a transaction table 52 containing transaction information 80. The column labeled "rebate status" can provide an indication of the current state of a rebate request from consumer 22. For example, a current status may be transaction initiated, awaiting rebate request form 24, processing information, awaiting verification, rebate request form 24 invalid, request denied, request approved, awaiting disbursement option 66 selection, fulfilling disbursement option 66, processing complete, or any other suitable status designation. Rebate processing center 12 may access and update a rebate status in processing rebates requests, for example, for notification responsive to a consumer 22 status request. *Id.*, at page 13, line 15 - page 14, line 27.

Ground Of Rejection To Be Reviewed On Appeal

I.   Appellants request that the Board review the Examiner's requirement under 37 C.F.R. § 1.78(b) to either cancel Claims 1, 3, 4, 6-11, 13, 14, 16-31, and 33-38 or maintain a clear line of demarcation between the present Application and Application No. 09/470,588.

II.   Appellants request that the Board review the Examiner's rejection of Claims 1, 3, 4, 6-11, 13, 14, 16-31, and 33-38 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,791,991, which issued to Small ("*Small*"), in view of U.S. Patent No. 6,330,544, which issued to Walker et al. ("*Walker*"), and U.S. Patent No. 6,039,244, which issued to Finsterwald ("*Finsterwald*").

Argument

I.   **Claims 1, 3, 4, 6-11, 13, 14, 16-31, and 33-38 are not properly rejected under 37 C.F.R. § 1.78(b), and good and sufficient reasons exist for the retention of these Claims in the present Application.**

    A.   **Claims 1, 3, 4, 6-11, 13, 14, 16-31, and 33-38 are not properly rejected under 37 C.F.R. § 1.78(b).**

In the *Final Office Action*, the Examiner indicates that, pursuant to 37 C.F.R. § 1.78(b), Claims 1, 3, 4, 6-11, 13, 14, 16-31, and 33-38 conflict with Claims 1-32 of co-pending Application Serial No. 09/470,588. Section 1.78(b) states:

> Where two or more applications filed by the same appellant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application.

Accordingly, the Examiner insists that Appellants "either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications." *Final Office Action*, at p. 2 (citing M.P.E.P. § 822). Appellants address this issue for purposes of completion and to avoid confusion.

The Examiner discusses this requirement in the *Final Office Action* under the heading "Double Patenting." However, the Examiner cannot reject Claims 1, 3, 4, 6-11, 13, 14, 16-31, and 33-38 under 37 C.F.R. § 1.78(b). Furthermore, the requirement that claims be canceled or a clear line of demarcation between applications be maintained "is appropriate only when the conflicting claims are patentably distinct." M.P.E.P. § 822. Thus, the Examiner has not actually made a double patenting rejection. For at least these reasons, Appellants request the Board to find that Claims 1, 3, 4, 6-11, 13, 14, 16-31, and 33-38 under not properly rejected under 37 C.F.R. § 1.78(b).

    B.   **Good and sufficient reasons exist for the retention of Claims 1, 3, 4, 6-11, 13, 14, 16-31, and 33-38 in the present Application.**

In addition, good and sufficient reasons exist for the retention of Claims 1, 3, 4, 6-11, 13, 14, 16-31, and 33-38. Claims 1-32 of co-pending Application Serial No. 09/470,588

have been allowed and will issue shortly.[1] Furthermore, Appellants have maintained and will maintain a clear demarcation between the applications. *See* M.P.E.P. § 822. Therefore, for at least these reasons, elimination of Claims 1, 3, 4, 6-11, 13, 14, 16-31, and 33-38 from the present Application is not required.

II. **Claims 1, 3, 4, 6-11, 13, 14, 16-31, and 33-38 are patentable over *Small*, *Walker*, and *Finsterwald*, whether there references are taken alone or in combination.**

The Examiner rejects Claims 1, 3, 4, 6-11, 13, 14, 16-31, and 33-38 under 35 U.S.C. § 103(a) as being unpatentable over *Small* in view of *Walker* and *Finsterwald*. To establish a *prima facie* case of obviousness, the Examiner must satisfy three criteria. First, there must be suggestion or motivation in the prior art to modify or combine the references. Second, there must be a reasonable expectation of success. Third, the modification or combination must teach or suggest all elements of the rejected claims. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Furthermore, the appropriate test under § 103 is whether the claimed invention, *considered as a whole*, would have been obvious or nonobvious. *Jones v. Hardy*, 727 F.2d 1524, 1529, 220 U.S.P.Q. 1021, 1025 (Fed. Cir. 1984).

A. **Claims 1, 3, 4, 6-11, 13, 14, 16-31, and 33-38 each include numerous limitations not taught or suggested by *Small*, *Walker*, or *Finsterwald*.**

Consider independent Claim 1:

> A computer-based interface for facilitating rebate processing, the interface operable to:
> display a plurality of product identifiers using the computer-based interface, wherein each of the product identifiers is associated with a product bearing a rebate;
> receive purchase information from a user, wherein the purchase information identifies a purchased product associated with a selected one of the product identifiers;
> receive a rebate request for a rebate on the purchased product, the rebate request having an associated rebate transaction identifier assigned by a remote rebate processing center;

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[1] Appellants note that 37 C.F.R. § 1.78(b) applies only when two applications are co-pending. However, once Claims 1-32 of Application Serial No. 09/470,588 issue, the two applications will no longer be co-pending. Therefore, the requirement to either cancel claims or maintain a clear line of demarcation between the applications may be rendered moot by the time the Board considers this appeal.

retrieve status information for the rebate request from the remote rebate processing center using the rebate transaction identifier;

display the status information;

receive authorization of the rebate request;

display rebate information retrieved from the remote rebate processing center, the rebate information comprising at least two disbursement options determined based on the purchase information, a first one of the disbursement options having a first cash value to a recipient and a second one of the disbursement options having a second cash value to a recipient, the first cash value different than the second cash value; and

receive a selection of the disbursement options.

This claim includes numerous elements not taught or suggested by *Small*, *Walker*, or *Finsterwald*, whether taken alone or in combination.

1.   Status information for a rebate request

For example, consider the portion of Claim 1 requiring that the interface for rebate processing be capable of displaying status information for a rebate request retrieved from a remote rebate processing center using a rebate transaction identifier. *Small*, the primary reference in this rejection, simply discloses a bingo game that can bring coupon and rebate information to the attention of a consumer. *Small*, Abstract. *Small* does mention that rebate forms along with proofs of purchase may be submitted to a fulfillment center for processing. *Id.*, at column 8, lines 18-24. However, *Small* fails to address any aspects of rebate processing that may take place following such a submission. Thus, understandably, *Small* fails to mention retrieving or displaying any status information for a rebate request.

Because reference to *Small* is unavailing, the Examiner turns to the disclosures of *Walker* and *Finsterwald* in an attempt to show these claimed aspects. The Examiner states:

> While <u>Small</u> does not disclose retrieving and display [sic] status information for the rebate request, <u>Walker</u> discloses maintaining a "status" field in the database to indicate the status of a rebate, e.g. [sic] issued, redeemed, etc. <u>Finsterwald</u> discloses another similar rebate processing system in which that [sic] status of the rebate request is displayed to the user (col 10, lines 21-25). Therefore, it would have been obvious to one of skill in the art at the time the invention was made to notify the customer in <u>Small</u> of the current status of the rebate request, such as approved, denied, processing, etc. One would have been motivated to notify the customer of the status of the rebate in order to provide better customer service and to enable the customer to provide additional information if needed.

Final Office Action, at pages 6-7 (underline in original). However, upon review, it is clear that neither *Walker* nor *Finsterwald* teach or suggest anything like the rebate request status information of Claim 1.

In general, *Walker* discloses a system for combining gift certificates or redemption vouchers with credit card processing systems. *Walker*, at column 4, lines 11-13. *Walker* defines a redemption voucher as "a printed item or other object having an inherent value derived from an underlying account accessible through a credit card clearing system." *Id.*, at column 6, lines 55-58. In particular, *Walker* teaches associating redemption vouchers with redemption voucher identifiers. *Id.*, at column 7, lines 55-58. The redemption voucher identifiers link or map to credit card holders' account numbers so that the redemption voucher may be processed as credit card transactions. *Id.*, at column 8, lines 22-30.

While *Walker* discloses tying redemption vouchers to credit card accounts, *Walker* fails to teach or suggest <u>displaying status information for a rebate request</u>. *Walker* discusses a certificate database that stores information regarding certificates corresponding to customer accounts, where the certificates are embodiments of redemption vouchers. *See Walker*, Figure 5 and column 12, line 59 - column 13, line 44. For example, *Walker*'s figure 5 depicts a table identifying three certificates corresponding to three different customer accounts. For each certificate, the table indicates a maximum value of the certificate and a "STATUS" indicating whether the certificate has been "ISSUED" or "REDEEMED." An "ISSUED" certificate is a certificate that "has been issued to its intended credit card account owner" but that "has not yet been presented to a merchant for redemption." *Id.*, at column 13, lines 9-13. A "REDEEMED" certificate presumably is a certificate that has been presented to a merchant for redemption by the credit card account owner. Thus, *Walker* discloses storing a database that indicates whether a redemption voucher has been issued to a customer and redeemed by the customer.

However, *Walker*'s "STATUS" for a redemption voucher is not status information <u>for a rebate request</u>. While *Walker* addresses statuses of redemption vouchers, *Walker* does not address statuses of <u>requests</u> of any type. There is no reason for *Walker* even to address statuses of requests. For example, requests for use of redemption vouchers are answered with immediate and simple "accept" or "deny" responses from a clearing authority. *See id*, at column 5, lines 27-38. Furthermore, *Walker* indicates that the "redemption voucher becomes immediately negotiable upon receipt by the account owner." *Id.*, at column 4, lines 49-50. In fact, one of the intended uses of redemption vouchers is for "merchants to accept and

benefit from redemption vouchers" and for "credit card owners to obtain and benefit from redemption vouchers that may be used at designated merchants or at any outlet of goods and services." *Id.*, at column 4, lines 49-50. In contrast, Appellants' system can provide detailed information regarding statuses of rebate requests in various stages of processing. For example, consider the description at page 14, lines 17-24 of the Appellants' specification, which states:

> Rebate status provides an indication of the current state of a rebate request from consumer 22, for example, transaction initiated, awaiting rebate request form 24, processing information, awaiting verification, rebate request form 24 invalid, request denied, request approved, awaiting disbursement option 66 selection, fulfilling disbursement option 66, processing complete, or any other suitable status designation.

The instantaneous nature of *Walker*'s processing teaches away from any such operation. Thus, *Walker* does not consider storing or displaying status information for any type of request, let alone a rebate request as disclosed in Claim 1.

In addition, *Walker* simply does not show a user interface that can retrieve status information for a rebate request using a rebate transaction identifier assigned for the rebate request, nor does *Walker* show a user interface that can display the status information for the received rebate request. Thus, while *Walker* discloses back-end processing of a credit card transaction using a database that stores information regarding whether a redemption voucher has been redeemed, this fails to show displaying status information for a rebate request.

Similarly, *Finsterwald* fails to teach these claimed aspects. In general, *Finsterwald* teaches specific techniques for enabling rebate or coupon systems. *Finsterwald*, at column 1, lines 8-9. More specifically, *Finsterwald* teaches a system that generates unique codes and then distributes these codes to consumers purchasing particular products. *Id.*, at column 1, lines 41-65. A consumer, having received a unique code at purchase, can then submit the code to receive "points" that may later be redeemed for other products or services. *Id.*, at column 2, lines 19-33. The *Finsterwald* system may store these points in an account created for the consumer. *Id.*, at column 9, lines 16-25. The Examiner cites to this point account as somehow teaching claim elements related to the status information for a rebate request. Specifically, the Examiner cites to a portion of *Finsterwald* that discloses how a customer can check the balance of the point account:

> When the customer 14 wishes to learn the state of his point
> account, or to trade in the collected points against a reward, then
> he can enter into contact with the data collecting station 1 via the
> Internet connection 19 and trigger the desired actions.

Id., at column 10, lines 21-25. The Examiner characterizes this excerpt from *Finsterwald* as showing a "rebate processing system in which [the] status of the rebate request is displayed to the user." *Final Office Action*, at pages 6-7.

However, as with *Walker*, *Finsterwald*'s point account balance fails to teach or suggest displaying status information for a rebate request. *Finsterwald* discloses that a customer can "learn the state of his point account." While *Finsterwald* does not further explain this concept, *Finsterwald* does disclose that the number of points in the point account "grows with each valid code transmitted by the customer" and that "points . . . can be cashed in in different ways to the advantage of the customer." *Id*, at column 10, lines 1-2 and column 2, lines 25-33. Thus, a customer might be able to learn the number of points in his point account. However, learning the number of points in a point account or otherwise learning the state of a point account simply fails to teach or suggest displaying status information for a rebate request.

Finsterwald also discloses that customers can "trade in the collected points against a reward." *Finsterwald* provides examples of rewards that a customer might select:

> These points or miles can then be cashed in in different ways to
> the advantage of the customer. Thus, it is for example
> conceivable to operate "Internet shopping" with these points, to
> change the collected points into e-cash, to purchase rights of
> use of specific Internet services with the collected points, or to
> participate in exclusive competitions, with the entitlement to
> participate being bought by the cashing in of a specific number
> of the collected points.

Id., at column 2, lines 25-33. However, trading in collected points against any reward simply fails to teach or suggest displaying status information for a rebate request.

Furthermore, *Finsterwald* does not show a user interface that can retrieve status information for a rebate request using a rebate transaction identifier assigned for the rebate request, nor does *Finsterwald* show a user interface that can display the status information for the rebate request.

Thus, neither *Small*, *Walker*, nor *Finsterwald*, whether taken alone or in combination, teach or suggest displaying status information for a rebate request. Perhaps sensing this, the Examiner goes on to state:

> Furthermore, it is common in a wide variety of applications to maintain, retrieve, and display status information about business transactions from tracking information in package delivery systems to loan status information in loan processing systems to purchase order status information in purchasing systems, etc.

Final Office Action, at page 10. This statement is insufficient to support the rejection of the claims for numerous reasons.

First, this statement fails to establish that any "common" art actually teaches or suggests status information for a rebate request, as claimed. The Examiner only discusses "a wide variety" of altogether unrelated applications and what the Examiner believes these applications show. Of the examples specifically cited, "tracking information in package delivery systems," "loan status information in loan processing systems," and "purchase order status information in purchasing systems," none address status information for a rebate request. Furthermore, to the extent that the Examiner maintains this assertion based on "Official Notice," "well known prior art," "common knowledge," or other information within the Examiner's personal knowledge, Appellants have requested that the Examiner cite a reference in support of this position or provide an affidavit in accordance with 37 C.F.R. § 1.104(d)(2) and M.P.E.P. § 2144.03. *See Response After Final*, at page 13. However, to date the Examiner has not cited any reference or provided any affidavit.[2]

To summarize, the Examiner attempts to show that *Walker* and *Finsterwald* together teach or suggest a computer-based user interface operable, in part, to retrieve status information for a rebate request from a remote rebate processing center using a rebate transaction identifier assigned by the remote rebate processing center, and further operable to display the status information. The Examiner attempts to show the status information for the rebate request using a combination of *Walker*'s status of whether or not a certificate has been redeemed with *Finsterwald*'s brief disclosure of access to a point account balance. Appellants submit that neither of these disclosures deal with status information for a rebate request, nor do these disclosures teach or suggest the claimed aspects related to the status information for a rebate request.

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[2] In the *Advisory Action*, the Examiner states:

> The Appellant's [sic] argument in referenc [sic] to the "Official Notice" or common knowledge section of the rejection did not dispute the well known examples given in the rejection and is, therefore, not considered to traverse the wel [sic] known features [sic].

Advisory Action, at page 2. However, this statement is factually incorrect. *See Response After Final*, at page 13.

2.   Rebate information including at least two disbursement options

Also consider the portion of Claim 1 requiring that the interface for rebate processing be capable of displaying rebate information retrieved from the remote rebate processing center, where the rebate information comprises at least two disbursement options determined based on purchase information.

As teaching for this element, the Examiner cites the following portion of *Small*:

> Also, at block 85, a menu 90 (FIG. 4) is displayed in a payment window 91 to allow the consumer to select the preferred method of payment from a variety of payment methods. For example, an electronic funds transfer can be made to the consumer's bank account, a credit balance can be added to the consumer's credit card, a gift certificate or credit voucher can be generated for a participating retailer, or a check can be issued and mailed directly to the consumer.

Small, at column 7, lines 36-43. However, *Small* deals with a bingo game that can bring coupon and rebate information to the attention of a consumer. Moreover, the cited portion of *Small* discusses allowing a customer to select between different prizes for winning a bingo game. *Id.*, at column 7, lines 14-35.

Allowing a customer to select between different prizes for winning a bingo game fails to teach or suggest displaying rebate information retrieved from a remote rebate processing center. *Small* does not even consider processing of rebates, let alone displaying rebate information retrieved from a remote rebate processing center. Furthermore, allowing a customer to select between different prizes for winning a bingo game fails to teach or suggest disbursement options determined based on purchase information. In contrast to the claimed invention, *Small* discloses conducting a bingo game and offering prizes for winning combinations of bingo spaces. *Id.*, at column 7, lines 14-35. Thus, reference to *Small* is unavailing.

The Examiner does not rely on *Walker* or *Finsterwald* to teach or suggest the rebate information including the disbursement options. Furthermore, *Walker* or *Finsterwald*, alone or in combination with *Small*, fail to teach or suggest an interface for rebate processing that is capable of displaying rebate information retrieved from a remote rebate processing center, where the rebate information comprises at least two disbursement options determined based on purchase information.

Thus, Appellants submit that the cited references, even when combined, fail to show all of the elements of Claim 1. For substantially similar reasons as those discussed above,

Appellants submit that the *Small-Walker-Finsterwald* combination, as applied to independent Claims 11, 21, and 31, is similarly inappropriate and insufficient to show obviousness. Therefore, for at least these reasons, Appellants request the Board to overturn the rejection of independent Claims 1, 11, 21, and 31 and their respective dependent claims.

B.   There is no teaching, suggestion, or motivation to combine or modify the teachings of *Small*, *Walker*, or *Finsterwald* either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

There is no teaching, suggestion, or motivation to combine or modify the teachings of *Small*, *Walker*, or *Finsterwald*. Furthermore, the Examiner impermissibly fails to cite any evidence of such a teaching, suggestion, or motivation.

According to the Federal Circuit, "a showing of a suggestion, teaching, or motivation . . . is an 'essential component of an obviousness holding.'" *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.* , 229 F.3d 1120, 1124-25, 56 U.S.P.Q.2d 1456, 1459 (Fed. Cir. 2000) (quoting *C.R. Bard, Inc., v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 U.S.P.Q.2d 1225, 1232 (Fed. Cir. 1998). Furthermore, while "evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved, ... [t]he range of sources available . . . does not diminish the requirement for actual evidence." *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Thus, it is a factual question that cannot be resolved on subjective belief and unknown authority, but must be based on objective evidence of record. *See In re Lee*, 277 F.3d 1338, 1343-44, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002). Indeed, the factual inquiry whether to combine or modify references must be thorough and searching. *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 U.S.P.Q.2d 1001, 1008 (Fed. Cir. 2001).

In the present case, the *Final Office Action* has not cited any evidence of a teaching, suggestion, or motivation to combine or modify the teachings of *Small*, *Walker*, or *Finsterwald*. Instead, the *Final Office Action* has merely stated that the teachings of one reference would improve the teachings of another reference. For example, the Examiner states that "[o]ne would have been motivated to notify the customer of the status of the rebate

in order to provide better customer service and to enable the customer to provide additional information if needed." *Final Office Action*, at page 7.

Appellants respectfully submit that this unsupported statement fails to provide the required teaching, suggestion, or motivation to combine. This statement represents the subjective belief of the Examiner, does not point to any known authority, and therefore is not based on objective evidence of record. Furthermore, this statement represents hindsight reconstruction of Appellant's invention. Thus, the Examiner has not provided any evidence of a teaching, suggestion, or motivation to combine the references, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art prior.

Furthermore, as noted above, *Small* deals with a bingo game that can bring coupon and rebate information to the attention of a consumer. While *Small* does mention that rebate forms along with proofs of purchase may be submitted to a fulfillment center for processing, *Walker* and *Finsterwald* do not address processing of rebate requests. Instead, *Walker* discloses a system for combining gift certificates or redemption vouchers with credit card processing systems and *Finsterwald* introduces a point collecting system that may offer rewards to customers. Thus, *Walker* and *Finsterwald* fail even to address processing of rebate requests.

Therefore, for at least these additional reasons, Appellants request the Board to reverse the rejection of independent Claims 1, 11, 21, and 31 and their respective dependent claims.

C.   The Examiner inappropriately fails to consider the claimed invention as a whole.

To sustain the rejection of Claim 1, the *Final Office Action* stitches together random, unrelated excerpts from *Small*, *Walker*, and *Finsterwald*. This violates basic requirements for sustaining any rejection. In addressing Appellants' claims, the claims must be considered as a whole:

> The test under § 103 is not whether an improvement or a use set forth in a patent would have been obvious or nonobvious. The test is whether the claimed invention, considered as a whole, would have been obvious or nonobvious. Failure to consider the claimed invention as a whole is an error of law.

Jones, 727 F.2d at 1529, 220 U.S.P.Q. at 1025 (citations omitted). *See also, Hartness Int'l. Inc. v. Simplimatic Eng'g Co.*, 819 F.2d 1100, 1108, 2 U.S.P.Q.2d 1826, 1832 (Fed. Cir. 1987) ("the inquiry is not whether each element existed in the prior art, but whether the prior art made obvious the invention as a whole for which patentability is claimed").

In contrast to this basic tenant of patent law, the Examiner attempts to show that random, unrelated excerpts from *Walker* and *Finsterwald* together teach or suggest a computer-based user interface operable, in part, to retrieve status information for a rebate request from a remote rebate processing center using a rebate transaction identifier assigned by the remote rebate processing center, and further operable to display the status information. More specifically, the Examiner attempts to show the status information for the rebate request using a combination of *Walker*'s status of whether or not a redemption voucher has been redeemed with *Finsterwald*'s brief disclosure of access to a point account balance. Appellants submit that neither *Walker* nor *Finsterwald* deals with status information for a rebate request, nor do they indicate that the Examiner has considered the claimed invention as a whole.

Status information is intertwined with the other elements of the claims, such as "the rebate request," "the remote rebate processing center," and "the rebate transaction identifier." For example, consider the specific requirement of Claim 1 that "the rebate request hav[e] an associated rebate transaction identifier assigned by a remote rebate processing center." Not only do the references fail to teach these elements, but the Examiner's use of unrelated excerpts from the three cited references fails to account for the interrelated nature and full meaning of these claim terms when Claim 1 is considered as a whole.

For these additional reasons, the Examiner's piecemeal reconstruction of Claim 1 is in contravention of a well established tenet of patent law. For substantially the same reasons as those discussed above, the Examiner's piecemeal reconstruction of independent Claims 11, 21, and 31, is similarly inappropriate. Therefore, for at least this additional reason, Appellants request the Board to reverse the rejection of independent Claims 1, 11, 21, and 31 and their respective dependent claims.
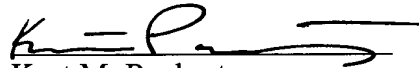
Conclusion

Appellants have demonstrated that the present invention, as claimed in Claims 1, 3, 4, 6-11, 13, 14, 16-31, and 33-38, is patentably distinct from the cited art. Accordingly, Appellants request that the Board reverse the final rejection of the Examiner and instruct the Examiner to issue a Notice of Allowance of Claims 1, 3, 4, 6-11, 13, 14, 16-31, and 33-38.

Appellants enclose a check in the amount of $250.00 to cover the fee. The Commissioner is hereby authorized to charge any extra fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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Appendix A - Claims Involved In Appeal

1.   (Previously presented) A computer-based interface for facilitating rebate processing, the interface operable to:

display a plurality of product identifiers using the computer-based interface, wherein each of the product identifiers is associated with a product bearing a rebate;

receive purchase information from a user, wherein the purchase information identifies a purchased product associated with a selected one of the product identifiers;

receive a rebate request for a rebate on the purchased product, the rebate request having an associated rebate transaction identifier assigned by a remote rebate processing center;

retrieve status information for the rebate request from the remote rebate processing center using the rebate transaction identifier;

display the status information;

receive authorization of the rebate request;

display rebate information retrieved from the remote rebate processing center, the rebate information comprising at least two disbursement options determined based on the purchase information, a first one of the disbursement options having a first cash value to a recipient and a second one of the disbursement options having a second cash value to a recipient, the first cash value different than the second cash value; and

receive a selection of the disbursement options.

2.   (Canceled)

3.   (Previously presented) The computer-based interface of Claim 1, further operable to:

receive a search string; and

display the product identifiers responsive to the search string.

4.   (Original) The computer-based interface of Claim 1, wherein the rebate request comprises a request for a rebate on a purchased product, and the disbursement options comprise a plurality of products related to the purchased product available to purchase using a rebate credit.

5.   (Canceled)

6.   (Original) The computer-based interface of Claim 1, further operable to:

display a plurality of products available to purchase using a credit associated with a selected one of the disbursement options;

        receive purchase selections from the plurality of products; and

        display a total price of the purchase selections.

7.   (Original) The computer-based interface of Claim 6, further operable to receive credit card information from the user if the total price exceeds the credit.

8.   (Original) The computer-based interface of Claim 1, wherein the interface comprises a site browser and further operable to display an additional site for purchasing products using a credit associated with a selected one of the disbursement options.

9.   (Original) The computer-based interface of Claim 1, wherein the disbursement options comprise a cash rebate and a credit voucher.

10.   (Original) The computer-based interface of Claim 1, wherein the credit voucher comprises a selected one of a retailer gift certificate, a manufacturer credit voucher, and a credit valid for an Internet purchase.

11.   (Previously presented) A method for processing a rebate, comprising:

displaying a plurality of product identifiers using a computer-based interface, wherein each of the product identifiers is associated with a product bearing a rebate;

receiving purchase information from a user, wherein the purchase information identifies a purchased product associated with a selected one of the product identifiers;

receiving a rebate request for a rebate on the purchased product, the rebate request having an associated rebate transaction identifier assigned by a remote rebate processing center;

retrieving status information for the rebate request from the remote rebate processing center using the rebate transaction identifier;

displaying the status information;

receiving authorization of the rebate request;

displaying rebate information retrieved from the remote rebate processing center, the rebate information comprising at least two disbursement options determined based on the purchase information, a first one of the disbursement options having a first cash value to a recipient and a second one of the disbursement options having a second cash value to a recipient, the first cash value different than the second cash value; and

receiving a selection of the disbursement options.

12.   (Canceled)

13.   (Previously presented) The method of Claim 11, further comprising:

receiving a search string; and

displaying the product identifiers responsive to the search string.

14.   (Original) The method of Claim 11, wherein the rebate request comprises a request for a rebate on a purchased product, and the disbursement options comprise a plurality of products related to the purchased product available to purchase using a rebate credit.

15.   (Canceled)

16.   (Original) The method of Claim 11, further comprising:

displaying a plurality of products available to purchase using a credit associated with a selected one of the disbursement options;

receiving purchase selections from the plurality of products; and

displaying a total price of the purchase selections.

17.   (Original) The method of Claim 16, further comprising receiving credit card information from the user if the total price exceeds the credit.

18.   (Original) The method of Claim 11, further comprising linking to a site for purchasing products using a credit associated with a selected one of the disbursement options.

19.   (Original) The method of Claim 11, wherein the disbursement options comprise a cash rebate and a credit voucher.

20.   (Original) The method of Claim 11, wherein the credit voucher comprises a selected one of a retailer gift certificate, a manufacturer credit voucher, and a credit valid for an Internet purchase.

21.   (Previously presented) A rebate processor, comprising:

a memory operable to store a promotion comprising at least two disbursement options, a first one of the disbursement options having a first cash value to a recipient and a second one of the disbursement options having a second cash value to a recipient, the first cash value different than the second cash value; and

a processor, operable to:

receive a rebate request from a user;

assign a rebate transaction identifier to the rebate request;

communicate the rebate transaction identifier to the user;

match the rebate request to the promotion;

communicate an authorization of the rebate request, wherein the authorization comprises the disbursement options; and

receive a selection of the disbursement options.

22.   (Original) The rebate processor of Claim 21, wherein:

the promotion further comprises a first promotion identifier;

the rebate request comprises a second promotion identifier; and

the processor is further operable to match the rebate request to the promotion based on a comparison of the first promotion identifier and the second promotion identifier.

23.   (Original) The rebate processor of Claim 21, wherein the processor is further operable to:

receive purchase information from a consumer; and

identify the promotion based on the purchase information.

24.   (Original) The rebate processor of Claim 21, wherein the rebate request comprises a request for a rebate on a purchased product, and the disbursement options comprise a plurality of products related to the purchased product available to purchase using a rebate credit.

25.   (Original) The rebate processor of Claim 21, wherein the memory is further operable to store status information, wherein status information comprises a current status of the rebate request.

26.   (Original) The rebate processor of Claim 21, wherein the processor is further operable to:

communicate a product list, wherein the product list comprises a plurality of products available to purchase using a credit associated with a selected one of the disbursement options;

receive purchase selections from the product list; and

display a total price of the purchase selections.

27.   (Original) The rebate processor of Claim 26, wherein the processor is further operable to receive credit card information from the user if the total price exceeds the credit.

28.   (Original) The rebate processor of Claim 21, wherein the processor is further operable to communicate a location of a site for purchasing products using a credit associated with a selected one of the disbursement options.

29.   (Original) The rebate processor of Claim 21, wherein the disbursement options comprise a cash rebate and a credit voucher.

30.   (Original) The rebate processor of Claim 21, wherein the credit voucher comprises a selected one of a retailer gift certificate, a manufacturer credit voucher, and a credit valid for an Internet purchase.

31.   (Previously presented) A method for processing a rebate, comprising:

receiving purchase information identifying a product bearing a rebate;

communicating the purchase information to a remote rebate processing center using an electronic communications network;

receiving rebate information describing the rebate from the remote rebate processing center, the rebate information comprising at least two disbursement options, a first one of the disbursement options having a first cash value to a recipient and a second one of the disbursement options having a second cash value to a recipient, the first cash value different than the second cash value; and

displaying the rebate information;

receiving consumer information from a user, wherein the consumer information identifies a purchase of the product bearing the rebate;

communicating the consumer information to the remote rebate processing center to initiate a rebate request;

receiving a rebate transaction identifier from the remote rebate processing center, the rebate transaction identifier assigned to the rebate request by the remote rebate processing center;

outputting the rebate transaction identifier for physical delivery to the remote rebate processing center;

retrieving status information for the rebate request from the remote rebate processing center using the rebate transaction identifier; and

displaying the status information.

32.   (Canceled)

33.   (Original) The method of Claim 31, wherein the disbursement options comprise a list of products available to purchase using a rebate credit, wherein the list is determined based on the purchase information.

34.   (Original) The method of Claim 31, further comprising:

displaying a plurality of products available to purchase using a credit associated with a selected one of the disbursement options;

receiving purchase selections from the plurality of products; and

displaying a total price of the purchase selections.

35.   (Original) The method of Claim 34, further comprising receiving credit card information from the user if the total price exceeds the credit.

36.   (Original) The method of Claim 31, further comprising linking to a site for purchasing products using a credit associated with a selected one of the disbursement options.

37.   (Original) The method of Claim 31, wherein the disbursement options comprise a cash rebate and a credit voucher.

38.   (Original) The method of Claim 31, wherein the credit voucher comprises a selected one of a retailer gift certificate, a manufacturer credit voucher, and a credit valid for an Internet purchase.

Appendix B: Evidence

NONE

Appendix C: Related Proceedings

NONE